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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/431,519 11/01/99 CHUNG

S AH09480

EXAMINER

HM22/1009

PALAIYUR S KALYANARAMAN  
PATENT DEPT K-6-1 1990  
2000 GALLOPING HILL ROAD  
KENILWORTH NJ 07033-0530

LEVY, N

ART UNIT

PAPER NUMBER

1616 //

DATE MAILED:

10/09/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

43/519

Applicant(s)

CHUNG et al

Examiner

ABC Guy

Group Art. Unit

16/6 11

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 2/11/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-43 is/are pending in the application.
- Of the above claim(s) 21-43 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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Receipt is acknowledged of Request for time, and response (7/11/01 each).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-42 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 3.

This application contains claims 21-42 stand drawn to an invention nonelected with traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-13, 16 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Deasy.

The rejection of record is maintained.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deasy and Porter in view of Horykiewtsck.

The rejection of records is maintained.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al.

The rejection of record is maintained.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deasy in view of Ivy et al, O'Callaghan et al, Sivaramakrishnan and Kim et al.

The rejection of record is maintained.

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Claims 1-5, 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ivy.

The rejection of record is maintained.

Applicant's arguments filed 7/11/01 have been fully considered but they are not persuasive.

Applicant argues Deasy is multi-component, with added lactic/glycolic acid; thus it differs from the instant invention, and also is not added to by the secondary references. Lee is argued as not having actual formulations, while Deasy, Ivy, O'Callaghan, Sivaramakrishnan and Kim do not present the totality of the instant invention. Examiner finds the instant invention interpretable as it is claimed--it is a claimed composition as an implant--one part of which releases immediately, the other slowly, with some sort of cooperation required. The prior art show this, whether inclusive of more or other ingredients and components.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy:mv

September 19, 2001



**NEIL S. LEVY**  
**PRIMARY EXAMINER**